



UNITED STATES PATENT AND TRADEMARK OFFICE

50
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/543,962	04/07/2000	James Shanahan	D/99458	2107

7590 02/08/2005

John E Beck
Xerox Corporation
Xerox Square 20A
Rochester, NY 14644

EXAMINER

NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
----------	--------------

2176

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/543,962

Applicant(s)

SHANAHAN ET AL.

Examiner

Maikhanh Nguyen

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12/13/2004 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12/13/2004 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 12/13/2004 to the original application filed 04/07/2000; and IDS filed 12/31/2004.
2. Claims 1-37 are currently pending in this application. Claims 1, 19, and 28 have been amended. Claims 1, 19, and 28 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/13/2004 has been entered.

Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in

Art Unit: 2176

the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language; or " (Emphasis added.)

5. Claims 19-22 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by **Barrera et al.** (U.S. 6,567,800 – filed 03/2000).

As to independent claim 19:

Barrera teaches a method for acquiring information pertaining to a document including information (*Abstract*), comprising:

- a. associating a set of document service requests (*e.g., Products and Service, Information Source, Technology Development, Competitive Information, etc.; 701 in Fig. 7*) with the document (*Fig. 7*), wherein a document service comprises a process for using a portion of the information as a starting point to obtain other information from a service provider pertaining to the information (*e.g., "Products and Service" category is used in Fig. 7 as a starting point to obtain the information shown in Figs. 8-10*);
- b. autonomously acting and managing the document service requests without user intervention (*e.g., website content is automatically gathered and stored; col. 4, lines 4-15*), comprising:
 - (i) selecting a document service request from the set (*e.g., selects the "Products and Services" category 702; col. 5, lines 2-3*);
 - (ii) initiating and managing communication with a service provider to satisfy the selected document service (*e.g., a*

dynamically generated web page ...tailored to response to the query; col.5, lines 11-16); and

- (iii) integrating any results from the selected document service request into the document (*e.g., the results of the search are displayed to the user ... as a dynamically generated web page; col.5, lines 11-16 and Fig.10*).

As to dependent claim 20:

Barrera teaches the set of document service requests is selected from a group of pre-packaged document service requests (*see Fig.7*).

As to dependent claim 21:

Barrera teaches the results from the selected document service include a new document service request associated with the document (*e.g., The results of this category-content search are sent to the user; col.4, lines 54-65 and Fig.6/ The results of the search are displayed to the user ... 'dynamically generated web page' means a web page that includes content specifically tailored to response to the user query; col.5, lines 11-16 and Fig.10/ combination of category and content search provided ... produces website search result; col.5, lines 60-65*).

As to dependent claim 22:

Barrera teaches the document services are satisfied by a third party service provider via an Internet protocol (*col.2, lines 25-34; col.4, lines 4-15 and Fig.5*).

As to independent claim 28:

Art Unit: 2176

- a. The rejection of independent claim 19 above is incorporated herein in full.
Additionally, claim 28 further recites “a document including content information”.
- b. Barrera teaches a document including content information (*e.g., website content; col.4, lines 4-7*).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-18, 23-27, and 29-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Barrera et al.** (U.S. 6,567,800 – filed 03/2000) in view of **Doyle** (U.S. 6,510,432). Doyle was cited in the previously Office Action.

As to independent claim 1:

- a. It is directed to a system for performing the method of claim 19, and is similarly rejected under the same rationale. Additionally, claim 1 further recites “a scheduler”.

Art Unit: 2176

- b. Doyle teaches a scheduler (e.g., *the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ... the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claims 2-4:

They include the same limitations as in claims 20-22, and are similarly rejected under the same rationale.

As to dependent claim 5:

- a. Barrera does not specifically teach “the scheduler updates the set of document service requests on a predetermined schedule.”
- b. Barrera teaches the scheduler updates the set of document service requests on a predetermined schedule (*col.7, lines 50-60*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 6:

- a. Barrera does not specifically teach “the scheduler re-initiates selected document service request on a periodic basis.”
- b. Doyle teaches the scheduler re-initiates selected document service request on a periodic basis (*e.g., such gathering is provided by an automated process where searches on the web are periodically carried out to locate information on a user specified topic and that information retrieved and stored in a database so that the content is accessible independent of the status of the content on the web; col.4, lines 14-23*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 7:

- a. Barrera does not specifically teach “the periodic basis is determined by the selected document service request.”
- b. Doyle teaches the periodic basis is determined by the selected document service request (*e.g., the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ...the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of

Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 8:

- a. Barrera does not explicitly teach “the meta-document, the scheduler and the service providers reside at the same location.”
- b. Doyle teaches the meta-document, the scheduler and the service providers reside at the same location (*col.1, line 41- col.2, line 3 and col. 9, lines 50-60*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 9:

- a. Barrera does not explicitly teach “the meta-document, the scheduler and the service providers reside at the same location.”
- b. Doyle teaches the meta-document, the scheduler and the service providers reside at different locations (*col.4, lines 40-62 and col.14, lines 24-31*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how

often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 10:

Barrera teaches the set of document service s follow a predetermined sequence of calls to service providers for extracting information from other documents, databases and data stores (*col.3, lines 60-67*) and for searching, for other information responsive to any extracted information from the other documents, databases and data stores (*col.4, lines 54-65*).

As to dependent claim 11:

- a. Barrera teaches the pre-determined sequence of calls to service providers are satisfiable asynchronously.
- b. Doyle teaches the pre-determined sequence of calls to service providers are satisfiable asynchronously (*col.8, lines 1-22*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 12:

Barrera teaches the document and the set of document service requests are user-selectable (*col.4, lines 54-65 and Fig.1*).

As to dependent claim 13:

Art Unit: 2176

- a. Barrera teaches a user may select a document service request from the set and initiate and manage communication with a service provider to satisfy the selected document service, but does not specifically teach “the scheduler”.
- b. Doyle teaches the scheduler (e.g., *the periodicity defines how often the search and archive agent will search the data source ... the periodicity may be hourly ... the topic is currently event, then the periodicity may be daily, weekly or even monthly; col.7, lines 50-60*).
- c. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to include the feature from Doyle in the system of Barrera because it would have provided the capability for defining how often the search and archive agent will search the data sources accessible through the network for information content on the topic.

As to dependent claim 14:

Barrera teaches a list of document service requests from which the set of document service requests may be selected by a user (e.g., *searching all of the content of the universe of websites initially; col.2, lines 56-67 and Fig.1*).

As to dependent claim 15:

Barrera teaches the service provider is user-selectable (e.g., *searching all of the content of the universe of websites initially; col.2, lines 56-67 and Fig.1*).

As to dependent claim 16:

Barrera teaches a service provider can register additional document services to the list (e.g., *Registered Sites List; Fig.7*).

Art Unit: 2176

As to dependent claim 17:

Barrera teaches a list of service providers available for satisfying document services (*col.4, lines 4-34*).

As to dependent claim 18:

Barrera teaches the set of document service requests associated with the document are associated using metadata (*col.5, lines 43-46*).

As to dependent claim 23-25:

They include the same limitations as in claim 5-7, and are similarly rejected under the same rationale.

As to dependent claims 26-27:

They include the same limitations as in claims 10-11, and are similarly rejected under the same rationale.

As to dependent claims 29-34, 35-36 and 37:

They include the same limitations as in claims 2-7, 10-11 and 18, and are similarly rejected under the same rationale.

Response to Arguments

8. Applicant's arguments filed 08/18/2004 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dutta U.S Patent No. 6,772,208 issued: Aug. 3, 2004

Mukherjea et al., "Visualizing World-Wide Web search engine results", IEEE, July 1999.

Ron Vetter, "Comparing Internet Search Engines", IEEE, April 1997, pages 117-118.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on (571) 272-4090.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2176

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Maikhanh Nguyen
February 1, 2005


JOSEPH FEILD
SUPERVISORY PATENT EXAMINER